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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/803,419 | 03/18/2004 | Daniel D. Friel SR. | FRIEL-105 | 5873 |

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| EXAMINER | |
|---|---|
| SHAKERI, HADI | |
| **ART UNIT** | **PAPER NUMBER** |
| 3723 | |

DATE MAILED: 01/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

6

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/803,419 | FRIEL ET AL. | |
| | Examiner | Art Unit | |
| | Hadi Shakeri | 3723 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☐ Responsive to communication(s) filed on _____.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *63-88* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *81 and 82* is/are allowed.

6)☒ Claim(s) *63-78 and 83-87* is/are rejected.

7)☒ Claim(s) *79,80 and 88* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *15 December 2005* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 63-79 and 83-87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edling (4,285,253) in view of Leong (2,461,690) and/or Leong in view of Edling.

Edling meets all of the limitations of claim 63 and 83, i.e., achieving a fine smooth finish by a non-grinding means of utilizing a harden object, except for disclosing a non-motor-driven object. However, Edling discloses a superior finish by using steel, whether manual or mechanical (05:57-60) and discloses a preferred embodiment of mechanical means.

Leong teaches sharpening a knife by manual means. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the invention of Edling by using a manual means as taught by Leong, e.g., to save cost.

Regarding claims 64-79 and 83-87, Edling as modified by Leong meets all of the limitations, e.g., elongated flat surface (Edling, 34); stationary object (not movable); rotatable cylinder; braking mechanism (threaded connection) which is considered to meet the limitation of adjustable object (claim 70), however further modifying the invention for adjustability is well within the knowledge of one of ordinary skill in the art; grooved surface; Rockwell C-65; rods or rollers; handle; repeatedly moving the edge of the blade against the harden object meeting the limitations of "wedged" (to force into or through); and hardened object made of glass or crystal is considered to meet the limitation of claims 78 and 86, however, choosing a surface roughness

of less than 10 microns would have been obvious to one having ordinary skill in the art at the time the invention was made, dependent on work-piece/operational parameters, which involves only routine skill in the art, and since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller,* 105 USPQ 233.

Leong discloses a sharpening apparatus and method meeting all of the limitations of claims 63 and 83, except for disclosing a harden object. Edling teaches achieving a fine smooth finish by a non-grinding means of utilizing a harden object. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the invention of Leong by using a harden object as taught by Edling, e.g., for a superior finish.

Regarding claims 64-79 and 83-87, Leong as modified by Edling meets all of the limitations as noted above.

**3.** Claims 63-68, 70-75, 77-79 and 83-87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Friel (Des. 368,217) in view of Edling.

Friel meets all of the limitations of claim 63 and 83, i.e., knife-edge enhancing or conditioning apparatus and method having a precision angle knife guide, except for disclosing a hardened object for the sharpening tool.

Edling teaches achieving a fine smooth finish by a non-grinding means of utilizing a harden object. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the invention of Friel by substituting the sharpener with a harden object as taught by Edling to obtain a fine smooth finish.

Regarding claims 64-68, 70-75, 77-79 and 84-87, Friel as modified by Edling meets the limitations, as noted above and in previous office actions.

**4.** Claim 69 is rejected under 35 U.S.C. 103(a) as being unpatentable over PA (prior art, Friel modified by Edling) as applied to claim 63 above, and further in view of Fletcher (4,450,653).

Friel modified by Edling meets all of the limitations of claim 69, i.e., except rotatable harden object with braking mechanism.

Fletcher teaches setting the harden object into a support by threaded means. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to further modify the modified invention of PA by using a threaded connection between the object and the support as taught by Fletcher for an adjustable object.

***Allowable Subject Matter***

**5.** Claims 81 and 82 are allowed.

**6.** Claims 79, 80 and 88 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

**7.** The following is a statement of reasons for the indication of allowable subject matter: a restraining mechanism (O-ring 20) applying a resistive force, i.e., the object being displaceable (as defined by Specification, not met by rotation of the object); inverted U shaped spring as recited in claim 80, and knife guide being pivotally mounted in a support member with an adjusting structure (Fig. 16A) as recited in claim 50, place these claims in condition for allowance.

***Conclusion***

**8.** Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Response to Arguments***

**9.** Applicant's arguments filed 12/15/05 have been fully considered but they are not persuasive. Applicant argues against the obviousness,rejections by the Declaration filed on 12/15/05, which appears to argue against the motivation to combine and that the combined references would not be operative. These arguments fail to provide evidence to traverse the rejections but presents arguments by the inventor traversing the rejection by arguing that the edge achieved by the references combined is not the same, motor driven apparatus is a different technology than a manual one, etc., which appear to have been more appropriate presented under the "Remakes" rather than under Rule 131, 132 affidavit. However the arguments fail to point out what part of claim limitations are not met by the combined references, since broadly providing manual activity to replace a mechanical or automatic means which has accomplished the same result involves only routine skill in the art, particularly in view of the teachings as noted in the office action.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some

teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, modifying an apparatus by utilizing manual means is considered obvious to one of ordinary skill in the art in order to save cost, particularly since Edling discloses a superior finish by using a steel, whether manual or mechanical (05:57-60) and discloses a preferred embodiment of mechanical means.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hadi Shakeri whose telephone number is 571-272-4495. The examiner can normally be reached on Monday-Friday.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hadi Shakeri
Primary Examiner
Art Unit 3723
January 5, 2006